

AMENDMENT
August 21, 2006

TUC920030096US1
Serial No. 10/690,883

REMARKS

Claims 1 – 19 remain in the application and stand rejected. Claims 2 – 7, 9 – 13, 15, 16, 18 and 19 are amended herein. The rejection of claims 1 – 19 is respectfully traversed.

The specification is objected to for failing to provide proper antecedent basis for the claims. Specifically, the specification is objected to because “[w]hat comprises a computer readable medium is not properly defined in the specifications. Computer-readable medium does not appear to be within the specifications. Therefore, it appears that computer-readable medium may comprise anything under the sun such as carrier waves.” Claim 1, for example, recites a “computer-readable medium having **stored** thereon a data structure” It is unclear to the applicants how a data structure could be stored on carrier waves. Furthermore, the specification provides that “Figure 3 shows a **preferred data structure example 160** of variable data for tabular data lists 146, 148, 150, 152, 154, as organized within the executable code modules 106, 110 of Figure 1 and **stored as the dynamic input data 108**, in accordance with the present invention.” Paragraph 0022 (emphasis added). “Preferably, input data store 108 is **non-volatile storage**, although, any suitable **volatile storage** may be used as well.” Paragraph 0016 (emphasis added). Therefore, the specification provides proper antecedent basis for the claims. Reconsideration and withdrawal of the objection to the claims is respectfully requested.

Claims 2 – 7, 9 – 13, 15, 16, 18 and 19 are rejected under 35 U.S.C. §112, second paragraph, essentially for beginning with “A” instead of “The.” Applicants are unaware of any such requirement in §112 and, further, note that both forms are equally acceptable. A quick search of the PTO’s searchable patent database for “3. A” results in **3,432,379** hits; it is reasonably likely that a significant portion of those hits are not independent claims. An independent claim is directed to the genus. Each independent claim may be

AMENDMENT
August 21, 2006

TUC920030096US1
Serial No. 10/690,883

directed to one species or an individual member, which may or may not be the same individual as recited in the independent claim. However, be that as it may, rather than belabor the issue, the applicants have amended claims 2 – 7, 9 – 13, 15, 16, 18 and 19 as indicated by the Examiner. Reconsideration and withdrawal of the rejection of claims 2 – 7, 9 – 13, 15, 16, 18 and 19 under 35 U.S.C. §112 is respectfully requested.

Claims 1 – 7 are rejected under 35 U.S.C. §101 as being “directed to non-statutory subject matter. The claim does not appear to limit the computer readable medium to embodiments, which fall within a statutory category.” The MPEP, §2106 sets forth specific steps that are to be followed in determining whether claims recite patentable subject matter. There is no indication that those steps have been followed in classifying claims 1 – 7 as being drawn to unpatentable subject matter. Moreover, “[t]o properly determine whether a claimed invention complies with the statutory invention requirements of 35 U.S.C. 101, Office personnel should **classify** each claim into one or more statutory or nonstatutory categories.” MPEP §2106(IV)(B) (emphasis added). Other than an assertion that the claims do “not appear ... fall within a statutory category” nothing has been provided to indicate to what nonstatutory category the claims are directed. Furthermore,

If the invention as set forth in the written description is statutory, but the claims define subject matter that is not, the deficiency can be corrected by an appropriate amendment of the claims. In such a case, Office personnel should reject the claims drawn to nonstatutory subject matter under 35 U.S.C. 101, **but identify** the features of the invention **that would render** the claimed subject matter **statutory** if recited in the claim.

Id., (emphasis added). No such indication has been provided. Be that as it may, however, “a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.” MPEP §2106(IV)(B)(1)(a). Claim 1 recites a “computer-readable medium having stored thereon a data structure” as noted hereinabove. Accordingly, it is believed that claims 1 – 7 are indeed directed to patentable subject matter under 35

AMENDMENT
August 21, 2006

TUC920030096US1
Serial No. 10/690,883

U.S.C. §101. Reconsideration and withdrawal of the rejection of claims 1 – 7 under 35 U.S.C. §101 is respectfully requested.

Claims 8 – 16 are also rejected under 35 U.S.C. §101 as being “directed to non-statutory subject matter. All the elements would reasonably be interpreted by one of ordinary skill in light of the disclosure [0018] as software. It appears that no hardware component is required to enable the functions to be realized.” However, “[w]hen a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim.” MPEP §2106(IV)(B)(1)(a). Claim 8 recites a

collaborative design system for designing web-based management interfaces with design functions distributed amongst a number of design groups, each said web-based management interface providing selection amongst a plurality of web pages selectable for display, said system comprising: a data generation module generating ... ; a collection of ... HTML template files including placeholders in markup text for dynamic input data; a page generation module selectively providing HTML documents ... ; and ... a page pointer table with a single entry for each of said HTML template files, each said single entry ... pointing to a corresponding repeatable data structure and a page map for tabular data lists ... displayed as a table on a generated said HTML document.

(emphasis added). Similarly, claim 14 is drawn to a “**system having a web-based management interface providing selection amongst a plurality of web pages selectable for display**” at lines 1 – 2(emphasis added). Further, the management interface of claim 14 substantially parallels the recitations of claim 8. Thus, very clearly, each of claim 8 and 14 “is recited in conjunction with a physical structure” and so, is a product claim. Furthermore, even if one were to find that claims 8 and 14 are not product claims, no “features of the invention [have been identified] that would render the claimed subject matter statutory if recited in the claim. *Supra*. Accordingly, because claims drawn to software in conjunction with a physical structure, and which is normally associated with execution on a computer, are not *ipso facto* unpatentable under 35 U.S.C. §101 and because nothing has been identified with any specificity as rendering the claims

AMENDMENT
August 21, 2006

TUC920030096US1
Serial No. 10/690,883

unpatentable, claims 8 – 16 are patentable product claims under 35 U.S.C. §101. Reconsideration and withdrawal of the rejection of claims 8 – 16 under 35 U.S.C. §101 is respectfully requested.

Claims 17 – 19 are also rejected under 35 U.S.C. §101 as being “directed to non-statutory subject matter. The claim does not appear to limit the computer usable medium to embodiments, which fall within a statutory category. Further, there appears to be no hardware component to enable the functions of the program code to be realized and therefore it is software per se.” Since when is “software per se” non-statutory and since when is a computer not considered hardware? Again, nothing has been provided to indicate to what nonstatutory category the claims are directed. *Supra*. Nor have any “features of the invention [been identified] that would render the claimed subject matter statutory if recited in the claim.” *Supra*. Claim 19 recites “a computer usable medium having computer readable program code thereon,” at line 2. Specifically, “a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory.” MPEP §2106(IV)(B)(1)(a). Accordingly, because the claims recite reciting “a computer usable medium having computer readable program code thereon,” because claims drawn to software, which is normally associated with execution on a computer, are not *per se* unpatentable under 35 U.S.C. §101; and, because nothing has been identified with any specificity that renders the claims unpatentable, claims 17 – 19 are patentable under 35 U.S.C. §101. Reconsideration and withdrawal of the rejection of claims 17 – 19 under 35 U.S.C. §101 is respectfully requested.

Claims 1 – 3, 8, 11, 13, 14 and 17 are rejected under 35 U.S.C. §102(e) over U.S. Patent No. 7,039,658 B2 to. Claims 4 – 7, 9, 10, 12, 15, 16, 18 and 19 are rejected under 35 U.S.C. §103(a) over Starkey in further view of published U.S. Patent Application No. 2002/0138509 to Burrows et al. The rejection is respectfully traversed.

AMENDMENT
August 21, 2006

TUC920030096US1
Serial No. 10/690,883

Starkey teaches a “web page generator [that] includes applications for controlling web page operations or semantics and a plurality of templates for controlling the appearance of a web page.” Abstract, lines 1 – 2. The Starkey web page generator includes a “templates manager object [that] establishes Template Set Objects and Template Objects for each application on a dynamic basis.” *Id.* So, web pages are being dynamically generated from the templates and template objects. “Applications use this dynamic hierarchy to identify specific templates for use, **even templates** in the same or different applications **with the same name.**” *Id.*, (emphasis added). So, the applications select templates, even templates with the same name, to generate web pages. As far as the applicants can tell, the data for the Starkey web page templates are structured similar to the structure of the example of Figure 2 of the present application with reference to the corresponding description of paragraphs 0020 and 0021.

However, as described for the example of Figure 3 of the present application, “instead of storing a pointer to the beginning of a tabular list for each repeated item structure and an integer to describe the structure’s width, each page is described by an individual map 178, 180, which is a single data structure holding all of the information (offset pointers and column numbers) necessary to describe all of the repeated item structures on a given web page.” Paragraph 0023. The result, as described in paragraph 0024, is that much less space is required in “the data generation module 106 [that] receives and formats raw system data and stores it,” and in “the page generation module 110 [that] combines the data in data store 108 with the HTML templates 104 to create HTML documents 112 for display 114.” Paragraph 0018.

“A claim is anticipated only if each and every element **as set forth in the claim** is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868

AMENDMENT
August 21, 2006

TUC920030096US1
Serial No. 10/690,883

F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Furthermore, “[d]uring patent examination, the pending claims must be ‘given **>their<** broadest **reasonable** interpretation consistent with the specification.’” *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000)” MPEP, §2111 (emphasis added). Moreover, that “broadest reasonable interpretation of the claims **must also be consistent** with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).” *Id.* (emphasis added).

Regarding claim 1, it is asserted that the recited “page pointer table including link entries for each of a plurality of web pages selectable for display” is taught by Starkey at “Col. 2 lines 18-20, web pages are selectable for display. Col. 5 lines 30- 36 web pages stored on application server. On Col. 5 lines 48-50, application server contains a relational data management structure that contains data tables to store and link the information.” As noted hereinabove, Starkey generates web pages and therefore, does not store them. Further, there is nothing in Starkey to indicate or suggest that the “relational data management structure that contains data tables” is pointing to web pages. Starkey col. 2, lines 18 – 20 recites “the Donohoue et al. patent [U.S. Pat. No. 5,987,480] describes different versions of a web page available for different browsers. Each web page then must **include some means of determining** the conditions under which it, rather than a parallel web page, is selected for display” (emphasis added). This is not an element of Starkey, but a statement of a shortfall that Starkey addresses. Col. 2, lines 46 – 53. The Starkey application server 24 separates web page semantics and appearance functions to simplify administration. Starkey col. 5, lines 30 – 36. Starkey col. 5, lines 48 – 50 recites that the “application server 24 also includes a relational database with data tables 52 in the content store 26 that contain the data.” However, “search module 55 enables an application to generate queries that produce result sets containing data from the data tables 52 utilizing the information in the system tables 53 and data model 54.” *Id.*, lines 54 – 57. Data in this relational database is not “link entries for each of a

AMENDMENT
August 21, 2006

TUC920030096US1
Serial No. 10/690,883

plurality of web pages” as claim 1 recites and, therefore, the Starkey data tables 52 are not a “page pointer table” as recited in claim 1, lines 4 – 5.

Further, it is asserted that the Starkey templates are “repeatable data structures ... linked to one of said plurality of web pages;” and the template names are the recited “page maps” and criteria use for defining a particular table teaches a “page map pointing to ... corresponding tabular lists in a corresponding repeatable data structure” as recited by claim 1. However, a template name, especially when templates can have the same name (*supra*) is not a map to anything. Therefore, Starkey fails to teach the present invention as recited in claim 1.

Furthermore, because dependent claims include all of the differences with the cited reference as the claims from which they depend, claims 2 and 3, which depend from claim 1 are not taught or suggested by Starkey or any reference of record. Reconsideration and withdrawal of the rejection to claims 1 – 3 under 35 U.S.C. §102(b) is respectfully requested.

Regarding the rejection of claims 8 and 14, it is asserted that the Starkey templates are the “collection of hypertext mark up language (HTML) template files, ones of said HTML template files including placeholders in markup text for dynamic input data;” and also discloses “each said single entry for each of said ones pointing to a corresponding repeatable data structure” as recited for claim 1. So, the assertion is that the templates are both templates and “point to a corresponding” template. That is neither what is recited in claim 8 or 14, nor what is taught by Starkey.

Furthermore, for the recitation in claims 8 and 14 of a “page pointer table with a single entry for each of said HTML template files” the Office action again relies upon Starkey “Col. 5 lines 30- 36, web pages stored on application server. On Col. 5 lines 48- 50, application server contains a relational data management structure that contains data

AMENDMENT
August 21, 2006

TUC920030096US1
Serial No. 10/690,883

tables to store and link the information.” However, the Office action provides further explanation in “[t]hat is there exists a table with an entry for each of html template files.” An entry in a relational database, which maintains a relationship between data (data, not templates) in the table, is far from a pointer to each file in the table, much less a “page pointer table with a single entry for each of said HTML template files” as claims 8 and 14 recite. Similarly for the recitation in claims 8 and 14 of “a page map for tabular data lists in said corresponding repeatable data structure, said tabular data lists being displayed as a table on a generated said HTML document” the Office action again relies upon Starkey “Col. 7 lines 64-67, templates have names (i.e. corresponding map) that further use criteria by defining a particular table (i.e. points to one or more corresponding tabular lists).” As noted hereinabove, however, a template name, especially when templates can have the same name (*supra*) is not a map to anything. Therefore, Starkey fails to teach the present invention as recited in claims 8 and 14.

Since dependent claims include all of the differences with the cited reference as the claims from which they depend, claims 11, 13 and 14, which depend from claim 8 are not taught or suggested by Starkey or any reference of record. Reconsideration and withdrawal of the rejection to claims 8, 11, 13 and 14 under 35 U.S.C. §102(b) is respectfully requested.

Regarding the rejection of claim 17, it is asserted that the recited “computer readable program code means for generating variable data for display” is taught by Starkey at “Col. 6 lines 34-36, the invention contains modules that facilitates web page development and generation of responses that will produce a web page image at a browser.” So, it is being asserted that the Starkey web page image responses are the recited generated variable data. However, it is asserted that the recitation in claim 17 of “storing generated said variable data according to a page pointer table, said page pointer table having a single entry for each of a plurality of hypertext markup language (HTML) files” (emphasis added) is taught by Starkey at “Col. 5 lines 30-36, web pages

AMENDMENT
August 21, 2006

TUC920030096US1
Serial No. 10/690,883

stored on application server. On Col. 5 lines 48-50, application server contains a relational data management structure that contains data tables to store and link the information. That is there exists a table with an entry for each of html template files." However, as noted hereinabove, Starkey generates web pages and therefore, does not store them and, further, storing web pages falls far short of storing data generated for display according to a page pointer table as claim 17 recites. It is further asserted that Starkey teaches the recitation in claim 17 of "a single entry for each of a plurality of hypertext mark up language (HTML) files, each said single entry pointing to a corresponding repeatable data structure and a page map for tabular data lists in said corresponding repeatable data structure, said tabular data lists listing said generated data" substantially as recited for claims 1, 14 and 17. So again, the assertion is that templates are both the templates and "point to a corresponding" template. That is neither what is recited in claim 17, nor what is taught by Starkey. Therefore, Starkey fails to teach the present invention as recited in claim 17. Reconsideration and withdrawal of the rejection to claim 17 under 35 U.S.C. §102(b) is respectfully requested.

Regarding the rejection of claims 4, 10 and 18 under 35 U.S.C. §103(a) over Starkey in combination with Burrows, it is asserted that Burrows discloses "that there is the ability to put a limit on the length of reference chains for decompressing a row." However, that is not what claim 4 recites. Claim 4 recites that "page pointer table indicates the length of each of said one or more page maps." Claims 10 and 18 have analogous recitations. Limiting "the length of reference chains for decompressing a row" and providing a length indication in a pointer table (i.e., how long each page map is) are two very different things. Therefore, the combination of Burrows and Starkey does not result in the present invention as recited in claims 4, 10 or 18.

Claims 5 – 7 depend from claim 4 and claim 19 depends from claim 18 and, therefore, include this difference (of claim 4 or 18) with Burrows. Further, with regard to claims 7 and 9, Burrows is relied upon to show that "if the number of web pages in the

AMENDMENT
August 21, 2006

TUC920030096US1
Serial No. 10/690,883

network is large, the amount of memory required to store the url's and links in the web database will be correspondingly large." Claims 7 and 9 are directed to the above described advantages of the present invention. That is, as opposed to bloating the modules as described in paragraph 0023 of the present application, the "size of each of said executable modules [increases] only by the length of the corresponding said page pointer entry for each said added page." Therefore, the combination of Burrows and Starkey does not result in the present invention as recited in claim 5, 6 or 19, much less claims 7 or 9.

Moreover, since dependent claims include all of the differences with the cited references as the claims from which they depend, claims 4 – 7, 9, 10, 12, 15, 16, 18 and 19, which depend from claims 1, 8, 14 and 17 are not taught or suggested by Starkey and Burrows, alone or, further in combination with any reference of record. Reconsideration and withdrawal of the rejection to claims 4 – 7, 9, 10, 12, 15, 16, 18 and 19 under 35 U.S.C. §103(a) is respectfully requested.

The applicants have considered the other references cited but not relied upon in this rejection and find them to be no more pertinent than the references upon which the rejection is based.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance, both for the amendment to the claims and for the reasons set forth above, the applicant respectfully requests that the Examiner reconsider and withdraw the objection to the specification, reconsider and withdraw the rejection of claims 1 – 20 under 35 U.S.C. §§ 101, 102(a), 103(a) and 112 and allow the application to issue.

AMENDMENT
August 21, 2006

TUC920030096US1
Serial No. 10/690,883

The applicants note that MPEP §706 "Rejection of Claims," subsection III, "PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED" provides in pertinent part that

If **the examiner** is satisfied after the search has been completed that patentable subject matter **has been disclosed** and the record indicates that **the applicant intends to claim** such subject matter, he or she may note in the Office action that **certain aspects or features** of the patentable invention have not been claimed and that if properly claimed such claims **may be given favorable consideration**. (emphasis added.)

The applicants believe that the written description of the present application is quite different than and not suggested by any reference of record and that the claims as amended reflect those differences. However, should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below for a telephonic or personal interview to discuss any other changes.

Please charge any deficiencies in fees and credit any overpayment of fees to IBM Corporation Deposit Account No. 09-0449 and advise us accordingly.

Respectfully Submitted,

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